Appl. No.: 09/744,001
Group Art Unit: 1625
Applicants' Request for Reconsideration After Final

REMARKS

Claims 11-24 are currently pending in the present application.

In Paper No. 13, the Examiner withdraws the previous rejection of claim 23 under 35 U.S.C. §112, second paragraph, as being indefinite. Additionally, in Paper No. 13, the Examiner withdraws the previous rejection of claims 11-24 under 35 U.S.C. §103(a), as being unpatentable over European Patent Publication No. EP 0335295 A2 of Scholz, *et al.* (also referred to as "Quack" by the Examiner).

However, in Paper No. 13, the Examiner maintains the rejection of claims 11, 14 and 16 under 35 U.S.C. §112, first paragraph, as lacking enablement, apparently on the basis of the grounds set forth in the Office Action dated January 29, 2003 ("Paper No. 10"), "due to [A]pplicants' failure to modify in the amendment . . ." (*See,* Paper No. 13, p. 2).

Thus, claims 11, 14 and 16 stand finally rejected under 35 U.S.C. §112, first paragraph, as lacking enablement. Claims 12-13, 15 and 17-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Applicants respectfully traverse the Examiner's final rejection of claims 11, 14 and 16 as lacking enablement, and specifically submit that all pending claims satisfy the requirements of 35 U.S.C. §112, first paragraph, for the following reasons.

It is clear that the "enablement requirement" of 35 U.S.C. §112, first paragraph, mandates that the Specification describe to one of ordinary skill in the art how to make and how to use the claimed invention. However, it is equally clear and very well settled that the proper standard for judging the enablement provided by a disclosure is that which was set forth by the Supreme Court and accordingly adopted by the Court of Appeals for the Federal Circuit, namely, "is the experimentation needed to practice the invention undue or unreasonable?" (*See,* M.P.E.P. §2164.01, citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)).

An applicant does not need to provide a description of every possible embodiment in order to enable such embodiments. As long as one of ordinary skill in the art, upon reading the specification, can understand how to make and use the invention, and the experimentation

PAGE 5/9 * RCVD AT 3/29/2004 11:59:11 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729307 * CSID:+215 628 1345 * DURATION (mm-ss):13-08

required to determine the viability of any particular embodiment is not undue or unreasonable, then such an embodiment is enabled.

Applicants submit that the instant Specification contains sufficient information to enable one skilled in the art to make and use the claimed invention. Applicants' claimed invention is directed to a process for producing alkoxylated carboxylic acid esters, wherein the process comprises reacting a carboxylic acid ester with an alkylene oxide having from 2 to 4 carbon atoms in the presence of a catalyst mixture comprised of a sodium salt and a potassium salt selected from the group consisting of hydroxides, oxides, carbonates, alcoholates and carboxylates, wherein the weight ratio of the sodium salt to the potassium salt is from 20:1 to 1:20.

The Examiner has argued that only certain carboxylic acid esters are enabled, that only certain alkylene oxides are enabled, that only certain alcoholates are enabled, and that only certain carboxylates are enabled. Applicants submit that the Examiner is incorrect and has misinterpreted and misapplied the enablement requirement of the law. For example, it may well be that only several of the many existing carboxylic acid esters are specifically exemplified. However, this in no way limits the enablement provided by the Specification as to those compounds not specifically listed.

The information and disclosure provided in Applicants' Specification with respect to carboxylic acid esters would enable one of ordinary skill in the art to make and use the invention with ANY carboxylic acid ester *without resort to undue and/or unreasonable experimentation*. Applicants' Specification contains information which describes carboxylic acid esters which are suitable for use in the claimed process. Beginning at page 3, line 13, of the Specification, carboxylic acid esters suitable for use in the claimed process are described broadly, as "esters of carboxylic acids with monoalcohols or . . . polyols." (*See*, Applicants' Spec., p. 3, lines 14-16). Applicants' Specification also points out that preferred carboxylic acids useful in the disclosed esters include C_{6-22} carboxylic acids. (*See, id.*, at lines 16-17). Furthermore, specific examples of preferred carboxylic acids along with examples of preferred alcohols are provided in the Specification.

PAGE 6/9 * RCVD AT 3/29/2004 11:59:11 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729307 * CSID:+215 628 1345 * DURATION (mm-ss):13-08

One of ordinary skill in the art is likely to be a person with a chemistry or chemical engineering degree who is familiar with process technology. One of ordinary skill in the art, upon reading Applicants' Specification and being apprised of the variety of carboxylic acid esters that are disclosed as suitable for use in the claimed process, would be able to select any of such carboxylic acid esters and use them in the process as disclosed and exemplified. For one of ordinary skill in the art to substitute another carboxylic acid ester for the specifically exemplified lauric acid methyl ester set forth in the working example, no **undue** experimentation would be required. The process of the invention is well described in relation to the generic reactants. The legal standard for addressing enablement does not state that no experimentation can be required, but rather that no UNDUE experimentation should be necessary.

Similarly, the Specification discloses a variety of alkylene oxides and mixtures thereof which may be employed in the claimed process. (*See,* Applicants' Spec., p. 4, lines 15-18). The alkylene oxides specifically disclosed are ethylene oxide, propylene oxide, and/or butylene oxide. The alkoxylation reaction is described completely in the Specification, including the example. Throughout the description of the process in the Specification, the alkoxylation refers to "the aklyene oxide," not a specific compound. Upon reading the Specification, one of ordinary skill in the art would understand how to use a variety of alkylene oxides in the claimed process. No undue experimentation would be required to determine which alkylene oxides are preferred. Moreover, Applicants' Specification already notes that ethylene oxide is preferred.

Finally, in describing the catalysts, Applicants' Specification broadly discloses the use of sodium and potassium compounds such as, *inter alia*, alcoholates and carboxylates. The fact that specific alcoholates and carboxylates are exemplified verbatim in the Specification does not mean that other alcoholates and carboxylates lack enablement. One of ordinary skill in the art, upon reading the Specification and ascertaining that sodium/potassium alcoholates are suitable catalyst compounds, would recognize that any alcoholate or carboxylate which can be obtained or synthesized may be employed in the claimed process and no undue experimentation would be required to determine the viability of such a catalytic compound given the description of the entire process provided in the Specification.

PAGE 7/9 * RCVD AT 3/29/2004 11:59:11 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729307 * CSID:+215 628 1345 * DURATION (mm-ss):13-08

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Applicants respectfully submit that all pending claims are fully enabled. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph are respectfully requested.

In view of the remarks set forth above, Applicants submit that all pending claims satisfy the requirements of 35 U.S.C. §112, first paragraph. Accordingly, reconsideration, withdrawal of the rejection and a Notice of Allowance for all pending claims are respectfully requested.

Respectfully submitted,

ANSGER BEHLER, *et al.*

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(Date)

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PAGE 8/9 * RCVD AT 3/29/2004 11:59:11 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/1 * DNIS:8729307 * CSID:+215 628 1345 * DURATION (mm-ss):13-08